

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Case No. DNL2018-0050

Date 31 October 2018

1. The Parties

The Complainant is Digital Revolution BV of Nederhorst den Berg, the Netherlands, represented by Thijs Bregman, the Netherlands.

The Respondent is Domain Admin, Hush Whois Protection Ltd. of Providence, Mahe, Seychelles.

2. The Domain Name and Registrar

The disputed domain names <i23inkt.nl>, <123ikt.nl>, and <13inkt.nl> (the “Domain Names”) are registered with SIDN through Domain Robot.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 4, 2018. On September 5, 2018, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On September 6, 2018, SIDN transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. Pursuant to article 17.2 of the Regulation, the administrative proceeding shall be conducted in English whenever the Complainant or the Respondent neither resides nor is registered in the Netherlands. The Center sent an email communication to the Complainant on September 17, 2018, providing the registrant and contact information disclosed by SIDN and requesting the Complainant to submit an amended Complaint, translated into English. The Center verified that the amended Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 19, 2018. In accordance with the Regulations, article 7.1, the due date for Response was October 9, 2018. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 15, 2018.

The Center appointed Wolter Wefers Bettink as the panelist in this matter on October 19, 2018. The Panel finds that it was properly constituted. The panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

On the basis of the undisputed submissions and evidence provided by the Complainant, the following facts are established.

The Complainant has been operating a web shop in printer supplies under the domain name <123inkt.nl> since the year 2000, and currently has more than 2,000,000 customers and more than 300 employees. For every year since 2008, the Complainant has been chosen “Best web shop” by consumers in the Netherlands in the category computer, hardware, and software.

The Complainant is the owner of the European Union trade mark 123INKT, registered under no. 014573356 on February 1, 2016, and the Benelux device mark 123INKT.NL registered under no. 0913712 on April 10, 2012 (hereafter the “Trade Marks”).

The Domain Names have been registered on the following dates:

- <13inkt.nl>: January 16, 2012;
- <123ikt.nl>: December 20, 2009;
- <i23inkt.nl>: April 5, 2011.

The Domain Names resolve to a website with the heading “Koop dit domein” (“Buy this domain”), which contains buttons with printer-related captions, two of which display the trade mark 123INKT, and which includes the text “The Sponsored Listings displayed above are served automatically by a third party”.

5. Parties’ Contentions

A. Complainant

According to the Complainant, it has used the trade name “123inkt” and the domain name <123inkt.nl> since the year 2000. The Complainant further contends that for the past 10 years, its web shop at <123inkt.nl> has been chosen “Best web shop” by consumers in the category computer, hardware, and software at the “Nationale Thuiswinkel Awards” and the “Webshop Awards”. In addition, the Complainant submits that in 2010, 2015, and 2016, its web shop was a major winner of the overall customer award “Best web shop of the Netherlands”. The Complainant contends that this has been widely covered by national media such as “De Telegraaf”, “AD”, “de Pers:”, “nu.nl”, “Twinkle Magazine”, and others.

The Complainant states that the Domain Names differ only one character from the trade mark 123INKT, and are therefore confusingly similar to the Trade Marks.

The Complainant submits that the Respondent has no rights or legitimate interests in the Domain Names. In this context, the Complainant points out that it is well known, that it has been trading under the name “123inkt.nl” for more than 18 years, and it has not given written permission to the Respondent to use the Domain Names in any way whatsoever. Furthermore, the Complainant contends that a Google search on the Domain Names does not show any results that refer to the Respondent, but instead provides the suggestion: “did you mean: 123inkt.nl”, displaying the sponsored link to the website under the Complainant’s domain name <123inkt.nl>. In addition, the Complainant states that the Respondent has no reputation under a similar domain name.

According to the Complainant, the Domain names have been registered and are being used in bad faith. The Complainant submits that the Domain Names are typical cases of typo-squatting, where a consumer looking for the web shop of the complainant and making a mistake while typing the complainant’s domain name, ends up on a website owned by the respondent. The Complainant contends that the Domain Names have apparently been registered with the aim of generating advertising income by abusing the Trade Marks.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In accordance with paragraph 2.1 of the Regulations, to succeed the Complainant must satisfy the Panel that:

(i) the Domain Names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Names; and

(iii) the Domain Names were registered or are being used in bad faith.

The Respondent filed no response, so that the Complainant's claims were uncontested as such. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or fact.

In this regard the Panel notes that section 4.3 of the WIPO Overview of WIPO Panel views on selected UDRP Questions, Third Edition 1 ("WIPO Overview 3.0") stipulates that "a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. In cases involving wholly unsupported and conclusory allegations advanced by the complainant, or where a good faith defense is apparent (e.g., from the content of the website to which a disputed domain name resolves), panels may find that – despite a respondent's default – a complainant has failed to prove its case."

On the other hand, certain inferences may be drawn from the particular facts and circumstances of the case e.g., where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent.

In addition, as set out in section 4.8 of the WIPO Overview 3.0, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

In this context, the Panel notes that the Complainant has not submitted evidence of its statements relating to (i) its rights to the Trade Marks (other than their specific trademark registration numbers); (ii) its use of the trade names "123inkt" and "123inkt.nl" since 2000; (iii) the alleged reputation of the Trade Marks and the trade name; (iv) the awards the webshop of the Complainant has received; or (v) the media coverage of these awards.

A. Identical or Confusingly Similar

The Complainant has not provided documentary evidence of its rights in the Trade Marks. However, a simple search of the register of the Benelux Office of Intellectual Property's register, carried out by the Panelist, has confirmed that the Complainant is the owner of the rights in the Trade Marks.

In addition, in light of the timing of the Trade Marks, the Panel will also discuss the Complainant's rights in the trade names "123inkt" and "123inkt.nl", which it additionally relies on.

The Netherlands Trade Name Act protects trade names which are used in commerce by the company involved. Evidence of such use may be found in the letterhead, business card or directory entries containing the trade name, use of that name on the company's website, on its building and, generally, in any communication emanating from the company in which the trade name is used. The mere registration of a trade name in the Chamber of Commerce register ("Handelsregister") is not sufficient evidence as it does not prove the actual use of the name in commerce. Likewise, use of a logo or device mark containing the company's registered name is not regarded as evidence of use of a trade name, see, *Intertoys Holland B.V. v. Gaststaette Rasthaus*, WIPO Case No. DNL2017-0054.

With respect to its rights in the trade names "123inkt" and "123inkt.nl", the Complainant has submitted a copy of an extract of the Chamber of Commerce registration of its company with a registration of the additional trade names "123inkt" and "123inkt.nl". As set out above, registration of a trade name in the Chamber of Commerce register is not as such sufficient evidence of a trade name right, as it does not prove the use of the name in commerce.

Although the Complainant has not submitted further evidence to support its use of the trade names "123inkt" and "123inkt.nl", its statement that its web shop has for the past 10 years been chosen "Best web shop" by consumers in the category computer, hardware, and software by the "Nationale Thuiswinkel Awards" is confirmed by a simple Google search. A search for "123inkt.nl best webshop" shows that every year since 2008 the Complainant's web shop was chosen "Best web shop". A search of the domain name <123inkt.nl> with the Wayback Machine ("www.archive.org"), which has documented web pages since the 1990s, shows the web shop's homepage from various dates in 2008 with "123inkt.nl" in large lettering at the top of the page, in addition to the company name of the Complainant. In documented web pages from later years, "123inkt.nl" is used as reference to the company operating the web shop. In the view of the Panel, these specific uses of "123inkt.nl" can be considered use of a trade name. The Panel is thereby satisfied that the Complainant has used (and therefore has rights in) the trade name "123inkt.nl" since 2008 (hereafter the "Trade Name").

The Trade Marks and the Trade Name consist of or contain the name "123inkt", which is incorporated in its entirety in the Domain Names, in each case with a different misspelling. As set out in section 1.9 of the WIPO Overview 3.0, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered to be confusingly similar to the relevant mark for purposes of the first element. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark.

The country code Top-Level Domain ("ccTLD") ".nl" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

Therefore, the Panel finds that the Domain Names are confusingly similar to the Trade Marks and the Trade Name.

B. Rights or Legitimate Interests

While the overall burden of proof in proceedings under the Regulations is on the Complainant, previous panels have found that it is generally difficult, if not often impossible, to prove a negative (i.e., that the Respondent lacks any rights to or legitimate interests in the Domain Name), especially where the Respondent, rather than the Complainant, would be best placed to have specific knowledge of rights to or interests in the Domain Name. It follows that the Complainant has to make out a prima facie case

that the Respondent lacks rights to or legitimate interests in the Domain Name (see, e.g., LEGO Juris A/S v. Moensch, WIPO Case No. DNL2009-0052; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455). If the Complainant meets this requirement and the Respondent fails to rebut this, the required evidence is deemed to have been provided (see, e.g., Accor v. Eren Atesmen, WIPO Case No. D2009-0701).

The Complainant thus must make a prima facie case that the Respondent does not have a trade mark or other right corresponding to the Domain Names, was not authorized by the Complainant to use or register a domain name containing the Trade Marks or the Trade Name and did not (i) use or prepare to use the Domain Names in connection with a bona fide offering of goods or services before it was notified of the dispute; nor (ii) as an individual, business, or other organization has been commonly known by the Domain Names; nor (iii) is making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the Trade Marks or the Trade Name.

For this purpose, the Complainant has put forward that the Respondent had no permission for the registration and use of the Domain Names, does not appear to have a right of its own in the Domain Names, and is not known under the Domain Names or the name "123inkt". The Complainant has submitted a printout of the first results page of a Google search for each of the Domain Names, which shows links to the Complainant's web shop, but not to the Respondent.

The Panel concludes that the Complainant on balance with these statements has made out the prima facie case that the Respondent has no rights or legitimate interests in the Domain Name.

As no response has been filed, these statements and the evidence have remained uncontested.

On the basis of all of the above the Panel concludes that the Respondent has no rights or legitimate interests in the Domain Names.

C. Registered or Used in Bad Faith

Under the Regulations, it is sufficient for the Complainant to show that the Domain Names either were registered or are being used in bad faith. Evidence of bad faith registration may be found if the Complainant shows that at the time of the registration of the Domain Names the Respondent knew or should have been aware of the Complainant's rights in the Trade Marks or the Trade Name (see also WIPO Overview 3.0, section 3.2.2).

In this context, the Panel notes that SIDN has informed the Center that the Domain Names were initially registered on January 16, 2012 (<13inkt.nl>), on April 5, 2011 (<123inkt.nl>), and on December 20, 2009 (<123ikt.nl>) respectively. The Trade Marks, on the other hand, have been registered on April 10, 2012, and February 3, 2016 respectively. Therefore, all the Domain Names predate the registration of the oldest of the Trade Marks.

As set out in section 3.8.1 of the WIPO Overview 3.0, the mere fact that the Domain Names have been registered by the Respondent before the Complainant's trade mark rights accrued does not mean that the Respondent cannot be found to have registered the Domain Names in bad faith. However, for that purpose the Complainant will have to point to other circumstances (and submit additional evidence to support that statement) making it likely that the Respondent was or should have been aware of the Complainant's rights.

In this context, it is relevant to note that the Complainant has registered the domain name <123inkt.nl> on March 3, 2000, and has had an active website under that domain name since at least 2005. In addition, for every year since 2008, the Complainant in the Netherlands has been chosen “Best web shop” in its category, as set out above, under the Trade Name, which awards according to the Complainant have been widely publicized. The Panel further notes that (i) “123inkt”, which is the distinctive element of the Trade Name, is not a dictionary word or general expression; (ii) each of the Domain Names contains a different misspelling of the Trade Name; and (iii) the Domain Names were registered after the Complainant was chosen “Best web shop” for the second and fourth time respectively.

Under these circumstances, the Panel deems it likely that at the time of the registration of each of the Domain Names the Respondent was or should have been aware of the Complainant and the Trade Name.

Furthermore, a simple Google search prior to its registration of each of the Domain Names would have informed the Respondent of the existence of the Complainant and the Trade Name.

In addition, the Panel notes that evidence submitted by the Complainant shows that each of the Domain Names resolved to a web page which contained, inter alia, two sponsored hyperlinks to “123inkt”. This shows that the Respondent uses the Domain Names to seek to benefit from the repute of the Trade Marks and the Trade Name and from confusion with the Trade Marks and the Trade Name among Internet users searching for information in relation to publications under the Trade Marks or the Trade Name. Even if these sponsored links are served automatically by a third party, as a text on the website to which the Domain Names resolve claims, their being displayed on that website remains the responsibility of the Respondent, who allows the hyperlinks to be or to remain placed on the website (see also WIPO Overview 3.0, section 3.5).

Under these circumstances, and taking into account that the Respondent has not filed a response to rebut the submissions of the Complainant, the Panel on balance concludes that the Domain Names have been registered and are being used in bad faith.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain names <i23inkt.nl>, <123ikt.nl>, and <13inkt.nl> be transferred to the Complainant.

Wolter Wefers Bettink
Panelist